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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/072,504    05/04/98    HODOSH    M    760.1034

HM12/0702

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EXAMINER

ROSE, S

ART UNIT

PAPER NUMBER

1614

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DATE MAILED: 07/02/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/072504

Applicant(s)

HODOSH

Examiner

SHER ROSE

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4/29/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1625 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1625 are subject to restriction or election requirement.

## Applicant Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The November 27, 1998 Petition to Make Special was granted on February 17, 1999, and an outstanding restriction/election of species requirement mailed February 25, 1999 has been responded to on April 29, 1999, which response, on page 4 of the remarks quite clearly intends (b) carboxypolymethylene gel of claim 12 as the elected species.

Claim 12 corresponds to Example 5, Table III on page 10.

However, on March 1, 1999 applicant submitted an IDS citing references "to be called to the Examiner's attention" and the Examiner cannot fail to notice that two of them, i.e.: Fischer U.S. (5,851,512) and Fischer (5,855,870), both filed earlier than applicant, on May 30, 1997 have recently issued on December 22, 1998 and January 5, 1999, and contain claims to substantially the same invention as the elected species, namely carboxypolymethylene.

Applicant has failed to notify the PTO that the elected species corresponds to the claims of the recently issued Fischer patents whose May 30, 1997 filing date clearly antedates applicant's May 4, 1998 filing date herein.

37 CFR 1.607(c), as set forth in MPEP § 2307.05, requires the applicant to identify the patent and the number of the patent claims when presenting a claim which corresponds substantially to a patent claim.

This has not been done here.

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Claims 1-25 of this application have apparently been copied from a U.S. patent without being suggested by the examiner. The patent number and the number of the copied claims have not been properly identified. 37 CFR 1.607(c).

Applicant is required to identify the patent and claim numbers and supply information explaining why a complete identification of the copied patent claim(s) has not been presented. Following applicant's reply to this requirement or the abandonment thereof, this application will be forwarded by the examiner to the Office of the Assistant Commissioner for Patents for appropriate review as noted under 37 CFR 1.607(c).

Applicant is given a TIME PERIOD of ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication for reply to avoid abandonment of this application.

It is suggested that the non-elected claims be held in abeyance pending a determination as to whether applicant, as a junior party, should present the showing of evidence, 37 CFR 1.608 set forth in MPEP § 2308, 2308.01, 2308.02, since the Fischer patents cannot be overcome by presenting 37 CFR 1.131 Declarations but only through interferences.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday-Thursday from 7:30 A.M. to 6 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins, can be

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reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Shep Rose  
Senior Primary Examiner  
Art Unit 1614

SKR:cdc  
July 1, 1999

**SHEP K. ROSE  
PRIMARY EXAMINER  
GROUP 1200**